

The New European Patent System

*2017 International IP Court Conference
Patent Court of Korea • Daejeon • 6 September 2017*

Pierre Véron

Honorary President EPLAW (European Patent Lawyers Association)
Member of the Expert Panel group of the Unified Patent Court
Member of the Drafting Committee of the Rules of Procedure



VÉRON **VA**
& ASSOCIÉS
A V O C A T S

Paris ■ Lyon

Contents

- Why a new patent system in Europe?
- A new patent in Europe:
the European patent with unitary effect ('Unitary Patent')
- A new court for patents in Europe:
the Unified Patent Court (UPC)

Why a new patent system in Europe?

A new system was needed to remedy the drawbacks of the current patent system in Europe:

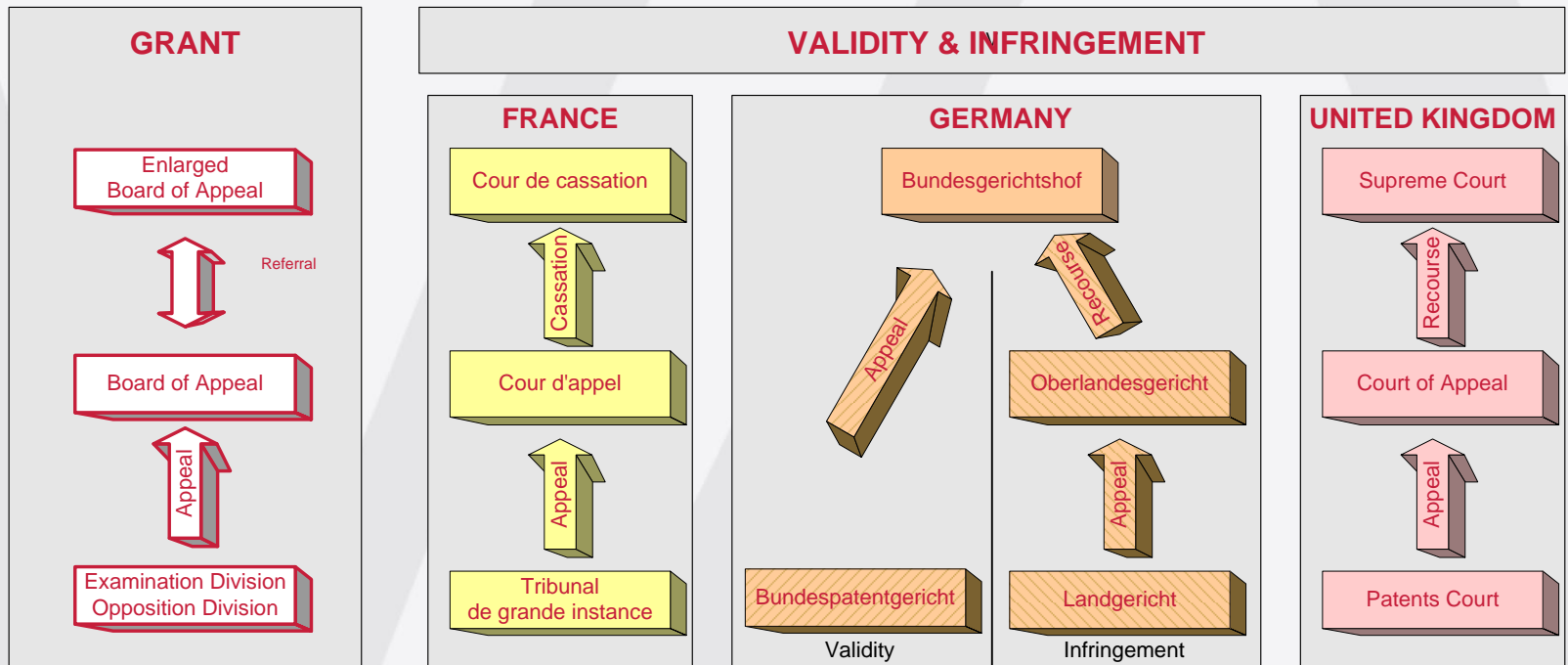
- Lack of real Europe-wide patent protection
- Jurisdiction given to national courts in parallel proceedings

Lack of real unitary patent protection: the current European Patent is a “bundle” patent, not a unitary patent

- The European Patent Office provides a single patent grant procedure
- However, the so-called ‘European Patents’ are **not** European **Union** patents or even Europe-wide patents: instead they are a ‘bundle’ of national patents
- When enforcement is needed, each national patent (‘designation’) must be enforced individually.



The current European Patent is a 'bundle patent': once granted by the EPO it becomes a series of 'national' patents to be enforced separately



Jurisdiction for validity and infringement

Jurisdiction for validity and infringement given to national courts in parallel proceedings causes:

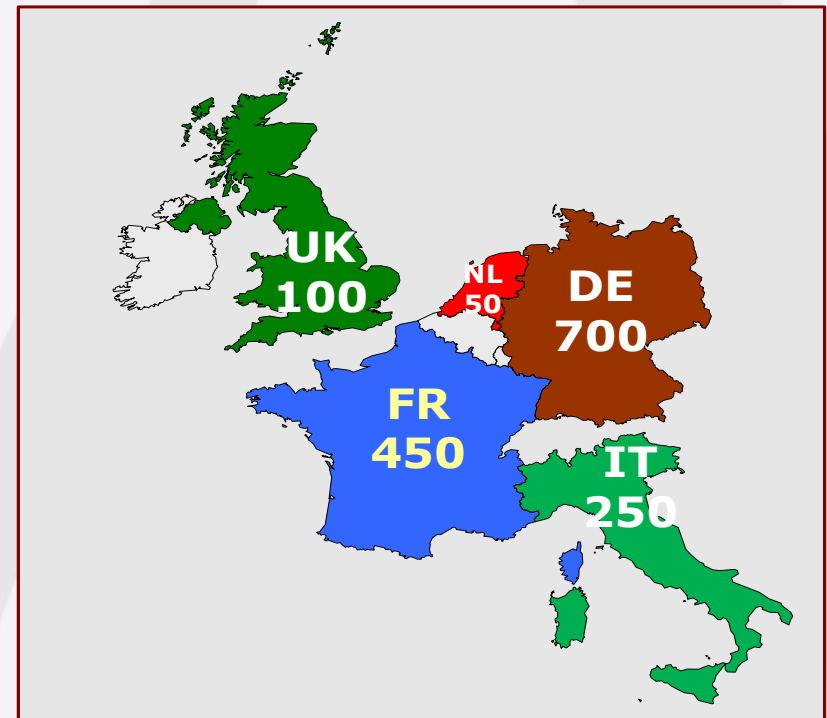
- *Forum shopping* strategies
(choose the best court where to bring your case)
- Conflicting decisions
(courts of various countries issue opposite rulings on the 'same' patent)

Patent litigation in Europe: figures

Number of new patent cases per year (rough estimate) in countries with ≥ 50 cases/year

Source: Harhoff

http://ec.europa.eu/internal_market/indprop/docs/patent/studies/litigation_system_en.pdf



Forum shopping in the current system

- Patentee or potential defendant
- Place of business of the other party
- Place of manufacture or marketing
- Main markets for the products
- Size of companies

Conflicting judgments

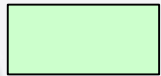
Novartis / Johnson & Johnson (contact lenses)



- **The Netherlands: patent valid and infringed**
11 February 2009 *Rechtbank The Hague*
- **France: patent valid and infringed**
27 October 2010 *Court of appeal Paris*
- **United Kingdom: patent invalid for insufficient description (but meeting novelty and inventive step requirements)**
High Court 10 July 2009
- **Germany: patent invalid for lack of novelty (but meeting description requirement)**
Bundespatentgericht 10 December 2009

Conflicting judgments

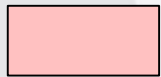
Novartis / Johnson & Johnson (contact lenses)



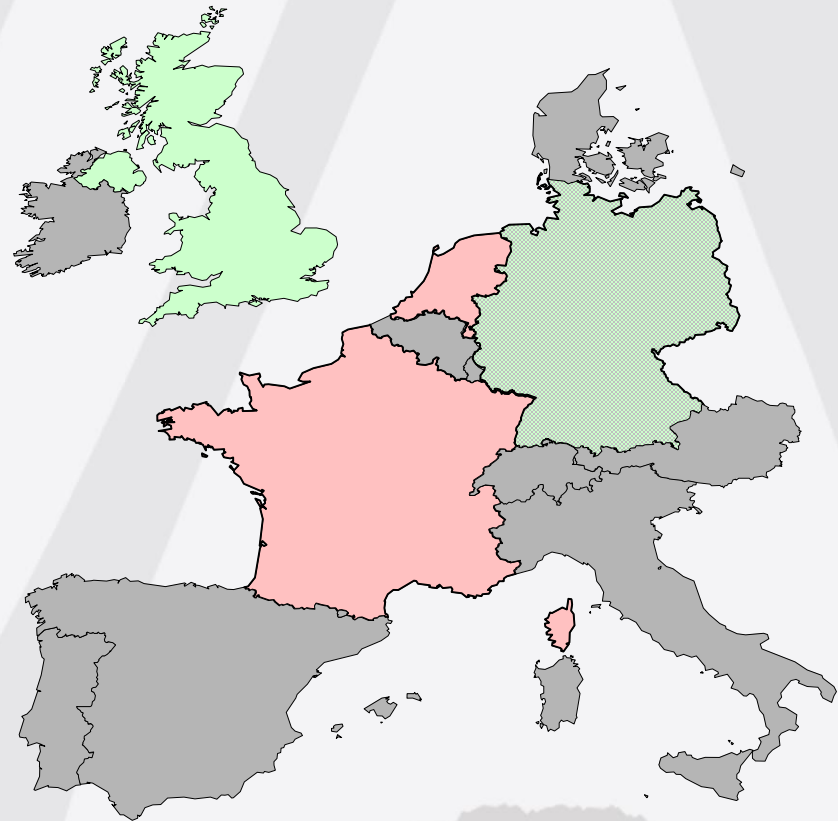
Patent held invalid
novel but insufficient description



Patent held invalid
sufficient description but not novel



Patent held valid
and infringed



Conflicting judgments

MSD v generics EP 0 724 444

(dosage regime of finasteride for the treatment of androgenic alopecia)

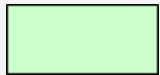
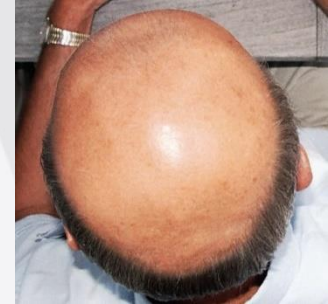


- **United Kingdom:**
patent invalid 1st instance
6 June 2007 *High Court*
patent valid and infringed appeal
21 May 2008 *EWCA*
- **Germany : patent invalid**
26 June 2008 *Bundespategericht*
- **France : patent invalid**
28 September 2010 *Tribunal de grande instance Paris* affirmed by court of appeal 30 January 2015
- **Spain : patent invalid**
Commercial court and court of appeal Madrid
- **The Netherlands : patent valid and infringed**
23 April 2014 *Rechtbank Den Haag*
- **Italy: patent valid in 1st instance and case settled on appeal**

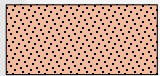
Conflicting judgments

MSD v generics EP 0 724 444

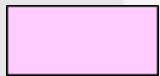
(dosage regime of finasteride for the treatment of androgenic alopecia)



Patent held invalid



Patent held invalid (1st instance), valid and infringed (appeal)



Patent held valid and infringed (1st instance, no appeal reported)



A new patent in Europe: the European patent with unitary effect (‘Unitary Patent’)



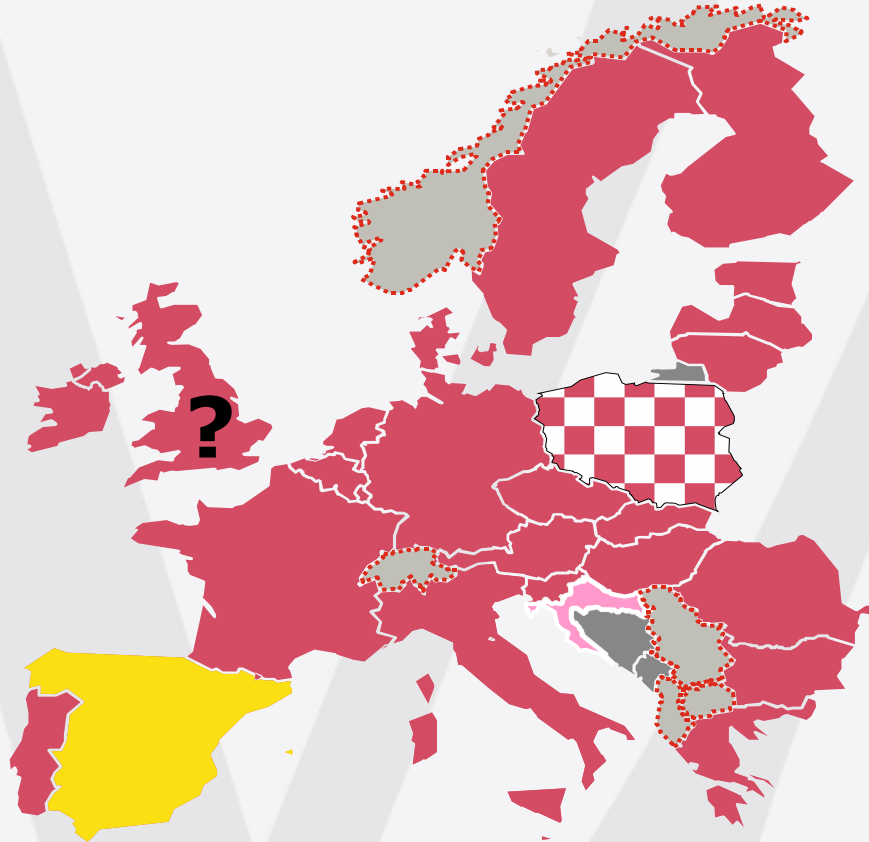
Signature of the
EU Regulations
on the Unitary
Patent
by the Presidents
of the European
Parliament and
the Council on
17 December
2012

The patents

- Three types of patent will be available in Europe:
 - ▶ national patent
 - ▶ classical European patent (bundle patent)
 - ▶ unitary patent (“European patent with unitary effect”)
 - ▶ double patenting possible in some countries:
national + EP/UP (DE, FR?, NL?)
- Not all European countries will be covered by unitary patent (CH, IS, NO, TR outside) but also ES, HR, PL and probably other countries until after their ratification (e.g. CZ, SK, RO); **UK?** (Brexit)

Unitary Patent and Unified Patent Court

Territorial coverage



25 UP
(EPO + EU + UP)

PL
(EP+UP NON UPC) 

ES
(EPO+EU NON UP NON UPC)

HR
(EU POST UP - POST UPC)

EPO
(NON EU)

(Five different Europes: EU, ÉPO, UP, UPC)

A new court for patents in Europe: the Unified Patent Court (UPC)

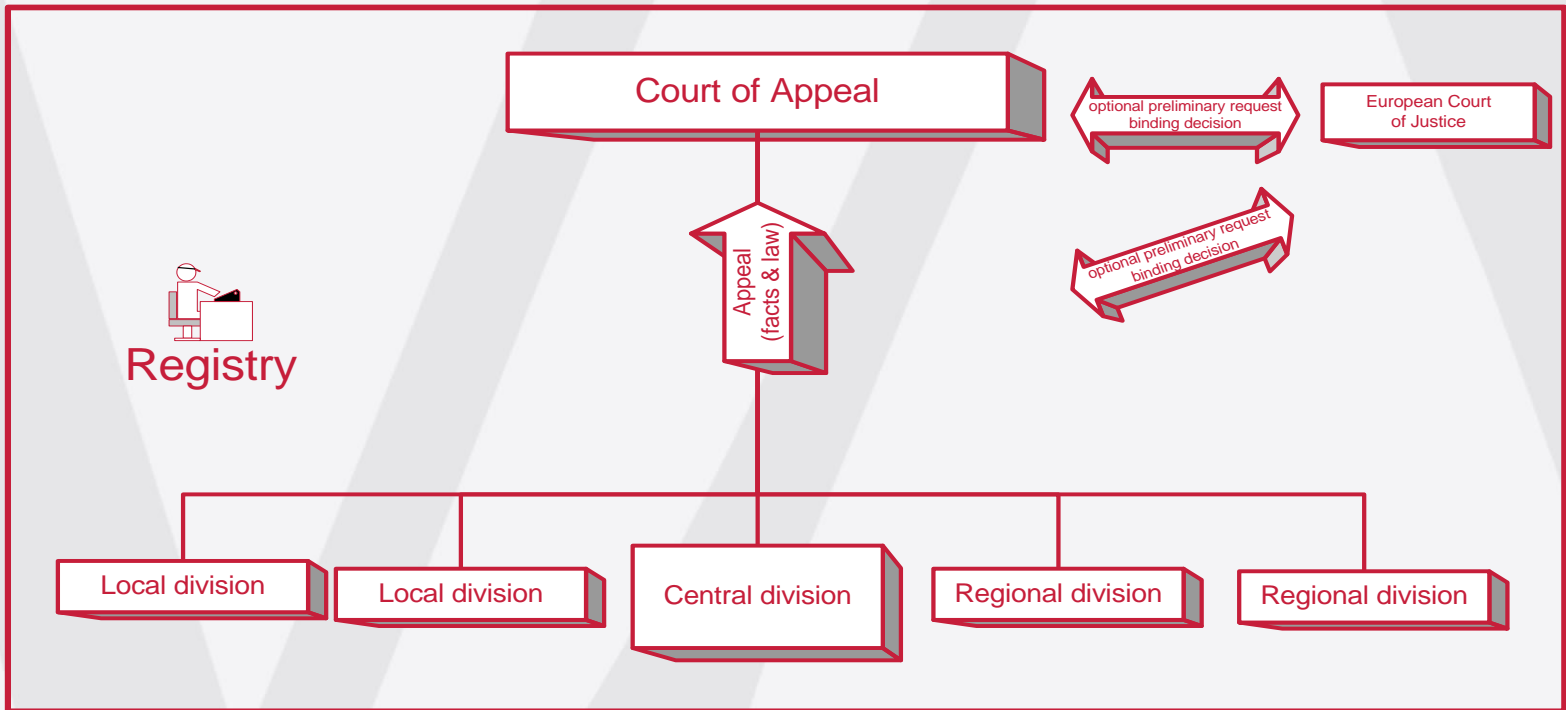


Signature of the Agreement on a Unified Patent Court
by the representatives of 25 Member States of the European Union
on 19 February 2013

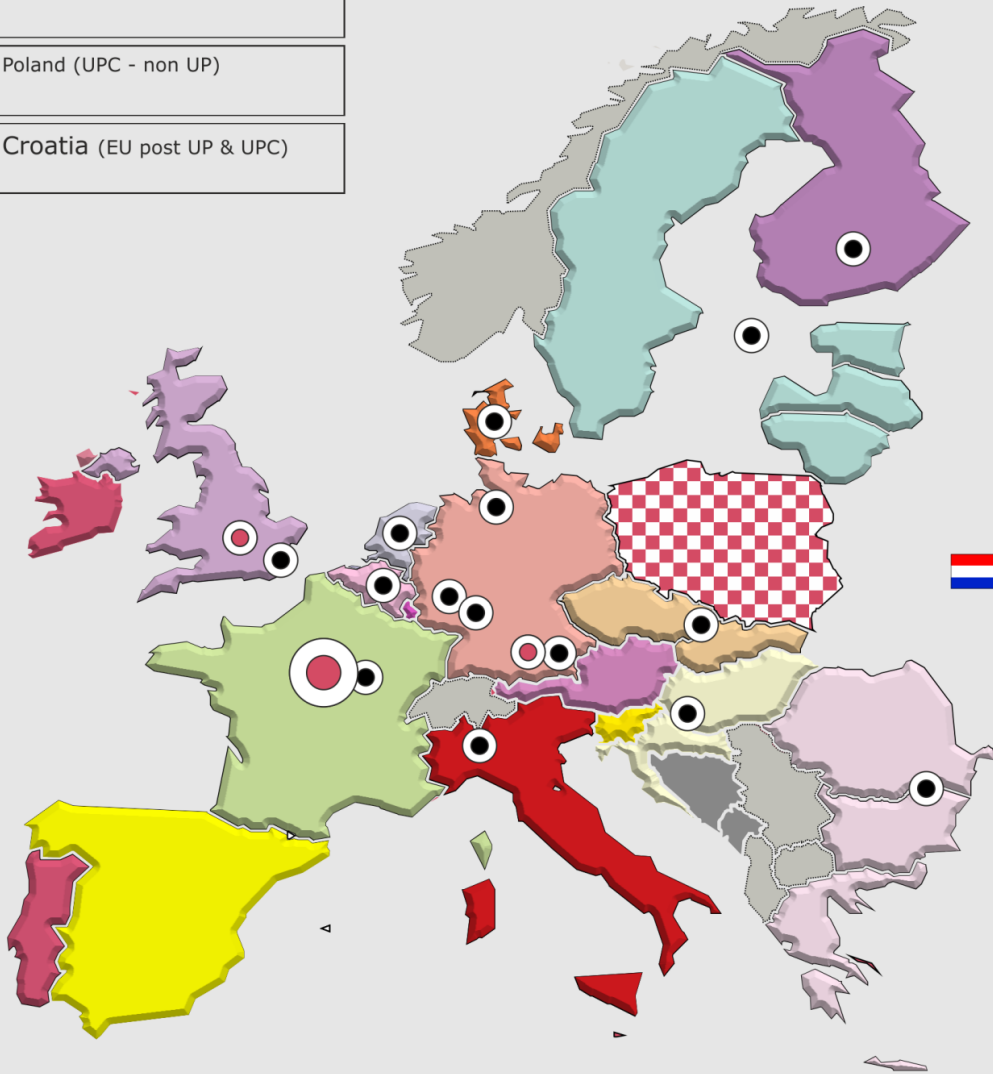
The courts: structure and people







































- Unified Patent Court (UPC) is a new court "*common to several EU Member States*" (not a federal court); it comes as an addition to national courts
- A court without Supreme court level control (ECJ to control only EU law issues)
- A court staffed with specialist judges in both first instance and appeal (including technically qualified judges when validity at stake)
- Multinational panels

Architecture of the Unified Patent Court



	Spain (non UP - non UPC)
	Poland (UPC - non UP)
	Croatia (EU post UP & UPC)



				Central Division also competent as "local" for: IE, LU, MT, PT
				Baltic Regional Division (SE, EE, LT, LV)
				Finland
				Denmark
				United Kingdom
				The Netherlands
				Germany (4 divisions)
				Belgium
				France
				Austria
				CZ-SK Regional Division ? (CZ, SK)
				Central Regional Division ? (HU, SI, HR)
				Eastern Regional Division ? (BG, CY, GR, RO)
				Italy (UP since 2015 - UPC)

The courts: venue and forum shopping

- During transitional period (7 years, possibly 14 years) concurrent jurisdiction of national courts and UPC for classical (bundle) EU patents, to the choice of the plaintiff
- Patentee may 'opt out' from the UPC system (except for a unitary patent)
- Wider forum shopping + language shopping than beforehand in Europe even between the UPC divisions themselves (central and local)
- Much wider forum shopping than in the US (place of infringement, no need for domicile)

The courts: discovery, proceedings

- No discovery available before the UPC
- Interlocutory injunction available; *saisie* available
- Superfast proceedings (predetermined schedule for the initial steps of the proceedings)
- Fully electronic proceedings
- All briefs and documents immediately available to the public unless specific request
- Written proceedings
- Case management (wide powers to the judge-rapporteur)

The courts: hearing, remedies

- Hearing generally limited to 1 day (hearing of a witness in person exceptional)
- Time between commencement of proceedings and judgment expected to be around 1 year
- Permanent injunction should be widely available (at the court's discretion, but most judges seem prepared to refuse it only in exceptional cases)

Recent uncertainties

- Brexit related issues (political and legal)
- Reluctance of some countries to agree for a provisional application causes (June 2017) the Preparatory Committee to reschedule the entry into operation of the UPC (previously scheduled for early 2018)
- German Constitutional Court suggests (June 2017) that German government should suspend the ratification process

Prepare however for entry into force

- Before entry into force
- Transitional period

Prepare before entry into force

- National patent? Classical EP “bundle” patent? Unitary patent? Both (national + EP)?
Language of filing?
Order of applicants in the patent application?
- Review collaboration or joint research agreements
- Review co-ownership and licence agreements

Prepare for transitional period

- To opt out or to stay in?
- If no opt-out, concurrent jurisdiction of UPC and national courts (claimant's choice)
- Applicable law may be different before the UPC and before national courts?

Legal sources



17 December 2012
Regulation 1257/2012 enhanced cooperation creation of unitary patent protection



17 December 2012
Regulation 1260/2012 (translation arrangements)



19 February 2013
Agreement on a Unified Patent Court and draft Statute

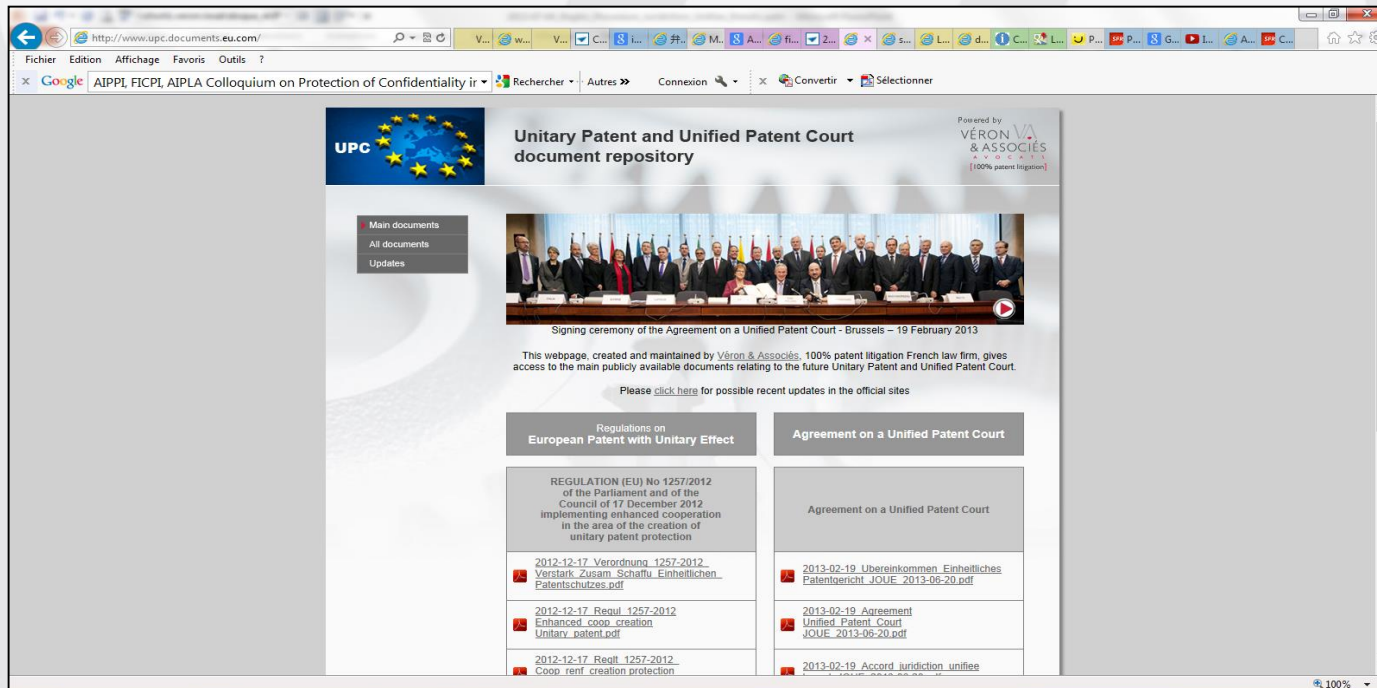


19 October 2015
Draft **Rules of procedure** Unified Patent Court (V18)



http://www.upc.documents.eu.com/PDFs/2014-10-31_Agreement_UPC_DE-EN-FR_and_Rules_Procedure_UPC_DE-EN-FR_Draft_17_and_Trier_hearing.pdf

The main publicly available documents can be found on
www.upc.documents.eu.com



Pierre Véron



1, rue Volney
75002 Paris
Tel. +33 (0)1 47 03 62 62
Fax +33 (0)1 47 03 62 69

105, rue Président Édouard Herriot
69002 Lyon
Tel. +33 (0)4 72 69 39 39
Fax +33 (0)4 72 69 39 49

pierre.veron@veron.com
www.veron.com

Thank you

VÉRON 
& ASSOCIÉS
A V O C A T S

